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Attorney Docket No.: 5442.400-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Outtrup et al.

Filed: August 24, 1999

Group Art Unit: 1652

Serial No.: 09/382,096

Examiner: Patterson, C.

For: Alkaline Bacillus Amylase

RESPONSE

Commissioner for Patents  
Washington, DC 20231

Sir:

This is in response to the Office Action mailed December 5, 2000, which accompanies Applicants' Request for Continued Examination (RCE) under 37 C.F.R. §1.114 and suspension of action on the above-identified application under 37 C.F.R. § 1.103(c) for a period of three months

REMARKS

Claims 1-8 and 16-19 are pending in the present application. The rejection of Claim 5 under 35 U.S.C. 112 as non-enabled is respectfully traversed below. The rejections of claims 1-8 and 16-19 under 35 U.S.C. 102 and 35 U.S.C. 103 are responded to in the form of Applicants' request for a suspension of the action for three months so as to provide time necessary to perform any testing necessary to resolve the 102 and 103 rejections, as discussed below.

I. **The Rejection of Claim 5 under 35 U.S.C. 112**

Claim 5 stands rejected under 35 U.S.C. 112 as non-enabled. The Examiner states that claim 5 claims retention of >90% activity under conditions at 25°C and <90% activity under the same conditions at 30°C. The Examiner alleges that there is "apparently no teaching of the activity of the enzyme under the conditions in the instant specification." This rejection is respectfully traversed.

It is respectfully submitted that claim 5 is enabled as the enzyme of claim 5 clearly has activity. Claim 5 is directed to an enzyme of claim 1, which retains a certain percentage of activity under the conditions specified in the claim and described in the specification at page. 5. The

determination of whether an enzyme falls within claim 5 is accomplished by performing the recited test. Applicants respectfully request reconsideration and withdrawal of the rejection.

**II. The 102 and 103 Rejections Over Mitsugi et al. and Boyer et al.**

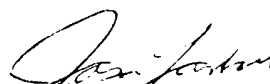
Claims 1-7 and 16 are rejected under 35 U.S.C. 102 as being anticipated by Mitsugi et al. (US Pat. No. 4,022,666) or Boyer et al. (US Pat. No. 4,061,541). Claims 8 and 17-19 are rejected under 35 U.S.C. 103 as obvious over Mitsugi et al. or Boyer et al. The Examiner contends that Applicants' assertion that the claimed enzymes are patentably distinct over the enzymes in the cited references is not sufficient to overcome the rejections, and, citing *In re Best, Bolton and Shaw*, 195 USPQ 430, 433 (CCPA 1977), the Examiner states that the PTO can require that Applicants prove that the prior art does not necessarily or inherently possess the characteristics of the claimed product.

In connection with Applicants' Request for Continued Examination (RCE) under 37 C.F.R. §1.114, Applicants have also requested a suspension of action under 37 C.F.R. § 1.103(c) for a period of three months so that Applicants can acquire the *Bacillus* species identified in Mitsugi and Boyer from the respective depository institution, and make any necessary comparison or evaluation.

The Examiner is hereby invited to contact the undersigned by telephone if there are any questions concerning this amendment or application.

Respectfully submitted,

Date: May 31, 2001



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